

REMARKS

The non-final Office Action mailed March 17, 2006 has been received and reviewed. Claims 1, 2 and 4-22 are pending. Claims 1, 2, and 18-22 are rejected. Claims 5-17 are allowed. Claim 4 is objected to, but otherwise determine to be allowable if rewritten. For the reasons stated below, the Applicant submits that the claims as currently presented distinguish over the cited references, are not obviated by the references and are in condition for allowance..

Rejection Of Claims 1, 2, And 18-22 Under 35 U.S.C. § 103(a)

Claims 1, 2, and 18-22 are newly rejected under 35 U.S.C. § 103(a) as being unpatentable over Paterson (WO 94/00082) in view of Eisenberg (DE 4013693). The Examiner states that Paterson discloses an orthopedic brace providing active resistance to axial rotation and translation in a joint comprising at least one circumferentially spiraling bracing member as claimed, but that Paterson does not specify that the spiraling bracing member is length-adjustable. The Examiner states that Eisenberg discloses a bracing member in an orthopedic brace that is length-adjustable to provide an accurate fit to the desired user. The rejection is traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings; second there must be a reasonable expectation of success; and third, the prior art reference or references must teach or suggest all the

claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Paterson and Eisenberg both fail, in the first instance, to disclose all of the claim elements recited in claim 1. Specifically, claim 1 requires at least one circumferentially spiraling bracing member having a proximal terminal positioned on one side of a joint and a distal terminal end positioned on the other side of the joint. Similar to Eisenberg, Paterson discloses a continuous strap (7, 8, 4) having a first terminal end (free end 9) which is positioned above the joint and a second terminal end, stitched to the leg wrap (2), which also terminates on the same side of the joint as the first terminal end.(9). As best seen in FIG. 2 of Paterson, the continuous strap comprises two separate straps numbered 7 and 8/4. Strap 7 and strap 8/4 are stitched together, the point of stitching being positioned above the joint, as seen FIG. 4 (just below the lower reference numeral 7). As shown in FIG. 2, strap 8/4 is a continuous length of material that terminates in a terminal end that is stitched (i.e., triangular stitching) to the leg wrap (2). The strap 5/6 which encircles the leg below the knee is simply stitched to the strap 8/4. As a result of the construction of Paterson, both terminal ends of the circumferential strap 7/8/4 are positioned on the same side of the joint, rather than on opposite sides of the joint as required by claim 1. Consequently, Paterson does not and cannot provide active resistance to axial rotation and translation in the joint. Neither Paterson nor Eisenberg teach a circumferentially spiraling bracing member having proximal and distal terminal

ends positioned on opposite sides of the joint as required by claims 1, 2 and 4, and, therefore, neither reference teaches or suggests structure that provides active resistance to axial rotation and translation in the joint. Not only do Paterson and Eisenberg fail to teach all that is claimed, but there is no motivation to combine or modify the references to achieve that which is claimed. Thus, claims 1, 2 and 4 are not obviated by Paterson and/or Eisenberg.

Claims 18-21 also require a circumferentially spiraling bracing member having a proximal terminal end structured for attachment to a first bracing member support positioned on one side of the joint and a second terminal end structured for attachment to a second bracing member support positioned on the other side of the point. As noted above, Paterson teaches a circumferentially spiraling strap having terminal ends that are both positioned on the same side of the joint, thereby being incapable of providing resistance to axial rotation. Eisenberg, too, teaches a continuous loop strap. Further, Eisenberg fails to teach any means, device, apparatus or structure for adjusting the length of the strap and the Examiner does not specifically cite to what device, apparatus or mechanism disclosed in Eisenberg meets that claim requirement. Consequently, neither Paterson nor Eisenberg teach the structure or function of claims 18-21, neither provides any motivation to combine or modify the disclosed structures to meet the requirements of the claims, and there is no reasonable expectation of success for making any such combination which is found in the references. Therefore, the references fail to establish a *prima facie* case of obviousness of claims 18-21.

Claim 22 requires at least one circumferentially spiraling bracing member having proximal and distal ends, and which spirals unidirectionally from one side of the joint to the other side of the joint to provide active resistance to axial rotation. For the same reasons as noted above with respect to claims 1 and 18, claim 22 is not obviated by the references because neither reference teaches the unidirectional spiraling of the bracing member as claimed. That is, both Paterson and Eisenberg teach a bidirectionally spiraling member which terminates on one side of the joint, spirals to the other side of the joint and spirals back in the other direction to terminate on the same side of the joint. Claim 22 is not obviated by the references for that reason. Additionally, Eisenberg fails to teach length adjustability as claimed.

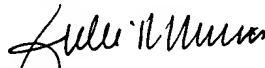
Rejection Of Claim 22 Under Obviousness-Type Double Patenting

Claim 22 is rejected on the ground of non-statutory obviousness-type double patenting. The Examiner states that although claim 22 is not identical to claim 1 of U.S. Patent No. 6,142,965, claim 22 is not patentably distinct in light of Eisenberg. The rejection is traversed. Claim 22 presents a patentably distinct invention from claim 1 of the '965 patent by requiring a length-adjusting circumferentially spiraling bracing member. As noted above, Eisenberg teaches no such length-adjusting means, device, mechanism or structure. Therefore, claim 22 is patentably distinct from claim 1 of the '965 patent and is not obviated by Eisenberg.

CONCLUSION

The Applicant submits that the claims present patentable subject matter. Reconsideration and allowance are requested. Should the Examiner have further questions or issues, particularly regarding the structure and operation of the invention, the Applicant requests that the Examiner contact the undersigned by telephone to discuss the matter further.

Respectfully submitted,



Julie K. Morriss
Registration No. 33,263
Attorney for Applicant
MORRISS O'BRYANT COMPAGNI, P.C.
136 South Main Street, Suite 700
Salt Lake City, Utah 84101
Telephone: (801) 478-0071

Date: June 19, 2006